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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,211	08/06/2001	Travis Wayne Cavender	2001-IP-004118	8979

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EXAMINER

SAFAVI, MICHAEL

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 08/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/923,211

Applicant(s)

CAVENDER, TRAVIS WAYNE

Examiner

M. Safavi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 24-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-16 and 24-35 are rejected under 35 U.S.C. 101 because the language of claims 1-16, particularly claims 1 and 24, appears to set forth an invention within each of two statutory distinct classes of subject matter.

Claim 1 appears to present an article of manufacture as by reciting "...gas storage and production system, comprising a gas storage formation" then proceeding to recite "a production wellbore extending into the formation". However, lines 4-5 of claim 1 appear to present a method as with the recitation of "and withdrawing gas from the formation". See, also, lines 6-7 of claim 1 which recites "a storage wellbore extending into the formation" as well as "and injecting gas into the formation". It is therefore, not clear as to what is being defined by the language of claim 1. Claim 1 apparently, is directed to an article of manufacture, namely a production wellbore and a storage wellbore. Claim 1 apparently, is also directed to a method of injecting and withdrawing gas. Claims 2-16 variously recite what appear to be method or process limitations.

Claim 24 appears to present an article of manufacture as by reciting "...gas storage and production system, comprising...a main wellbore...a storage wellbore...and a production wellbore". However, lines 7-9 of claim 24 appear to present a method or process as with the

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recitation of “gas being injected from the main wellbore into the formation via the storage wellbore” as well as “gas being withdrawn from the formation into the main wellbore via the production wellbore”. It is therefore, not clear as to what is being defined by the language of claim 24. Claim 24 apparently, is directed to an article of manufacture, namely a main wellbore, a storage wellbore and a production wellbore. Claim 24 apparently, is also directed to a method of injecting and withdrawing gas. Claims 25-35 variously recite article of manufacture limitations as well as method or process limitations.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 and 24-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 appears to present an article of manufacture as by reciting “...gas storage and production system, comprising a gas storage formation” then proceeding to recite “a production wellbore extending into the formation”. However, lines 4-5 of claim 1 appear to present a method or process as with the recitation of “and withdrawing gas from the formation”. See, also, lines 6-7 of claim 1 which recites “a storage wellbore extending into the formation” as well as “and injecting gas into the formation”. It is therefore, not clear as to what is being defined by the

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language of claim 1. Claim 1 apparently, is directed to an article of manufacture, namely a production wellbore and a storage wellbore. It is not clear as to what the recitation of “and withdrawing gas from the formation” or “and injecting gas into the formation” serves to define. Claims 2-16, particularly claims 3, 4, 10, and 14, variously recite article of manufacture limitations as well as method or process limitations.

Claim 24 appears to present an article of manufacture as by reciting “...gas storage and production system, comprising...a main wellbore...a storage wellbore...and a production wellbore”. However, lines 7-9 of claim 24 appear to present a method or process as with the recitation of “gas being injected from the main wellbore into the formation via the storage wellbore” as well as “gas being withdrawn from the formation into the main wellbore via the production wellbore”. It is therefore, not clear as to what is being defined by the language of claim 24. Claim 24 apparently, is directed to an article of manufacture, namely a main wellbore, a storage wellbore and a production wellbore. It is not clear as to what the recitation of “gas being injected from the main wellbore into the formation via the storage wellbore, and gas being withdrawn from the formation into the main wellbore via the production wellbore” serves to define. Claims 25-35, particularly claims 26-28, 31, 34, and 35, variously recite article of manufacture limitations as well as method or process limitations.

Further, it is not clear as to how the “production wellbore” “[withdraws] gas from the formation” nor, particularly, how the “storage wellbore” “[injects] gas into the formation”. And, it is not clear as to how the “production wellbore” is “withdrawing gas from the formation” at the

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same time the “storage wellbore” is “injecting gas into the formation”. Also, it is not clear as to how the “gas [is] being injected from the main wellbore into the formation via the storage wellbore” at the same time the “gas [is] being withdrawn from the formation into the main wellbore via the production wellbore”.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 2, 4, 5, and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott. Scott discloses, Fig. 3, first wellbore, (lower portion of 11), extending into a formation and a second wellbore 11a extending into a formation with well bore 11 intersecting wellbore 11a at a wellbore junction. Main wellbore, (upper portion of 11), extends from the wellbore junction to the earth's surface. Tubular string 14 is positioned within the main wellbore.

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5. Claims 1-5, 10, 14, 24-26, 31, 34, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Pringle et al. Pringle et al. discloses, Fig. 8, first wellbore 66 extending into a formation and a second wellbore 58 extending into a formation with well bore 66 intersecting wellbore 58 at a wellbore junction. Main wellbore, (portion extending from junction of 66 and 58), extends from the wellbore junction to the earth's surface. Tubular string 18 or 20 is positioned within the main wellbore with an annulus being formed around either of 18 or 20. First tubular string 18 and second tubular string 20 are positioned within the main wellbore.

Response to Arguments

6. Applicant's arguments filed June 24, 2003 have been fully considered but they are not persuasive. As for the rejection of claims 1-16 and 24-35 under 35 U.S.C. 101 and 35 U.S.C. 112, Applicant's example of a nail holding first and second boards together is not germane to the rejection at hand. In Applicant's example the recitation of a nail holding two boards together serves to define the claimed article of manufacture as by reciting that the first board and the second board are attached to one another via a nail. The recitation set forth in Applicant's example does not go beyond serving to define a feature of the claimed article of manufacture. Applicant's example does not establish a process under 35 U.S.C. 101. However, in the instant applications the claims rejected under 35 U.S.C. 112 and 35 U.S.C. 101 recite language which does not serve to further limit or further define the claimed article of manufacture. Rather, the language to which each of the 35 U.S.C. 112 and 35 U.S.C. 101 rejections allude is directed to a

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process which process is defined by the statutes as a separate and distinct invention apart from an article of manufacture. In other words, it is not seen where the claimed “gas storage and production system” by itself, and as presented within the claims, injects and withdraws gas from a formation. The injecting and withdrawing of gas would constitute a separate invention under 35 U.S.C. 101. With regard to Applicant remarks to “functional language”, recitation of “withdrawing” or “injecting” are not directed to functional language. Rather, the recitation of “withdrawing” or “injecting” appears directed to a process or procedural step with the function of the claimed wellbores being to act as a conduit, (or pathway), during any process of injecting or withdrawing.

Applicant’s remarks at the bottom of page 3 to the top of page 4 of the response do not serve to explain how, by themselves, the production and storage wellbores withdraw gas from a formation and inject gas into a formation. Applicant’s remarks may set forth a method which involves injecting and withdrawing gas, but those same remarks, (as well as passages to which Applicant alludes), do not define a process performed by the wellbores. Also, Applicant has failed to present a convincing explanation of how the claimed “gas storage and production system” is capable of withdrawing and injecting gas at the same time as is recited within each of claims 1 and 24. In other words, Applicant has not provided an adequate explanation of how the “production wellbore” is “withdrawing gas from the formation” at the same time the “storage wellbore” is “injecting gas into the formation”. Nor, has applicant provided an adequate explanation as to how the “gas [is] being injected from the main wellbore into the formation via

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the storage wellbore” at the same time the “gas [is] being withdrawn from the formation into the main wellbore via the production wellbore”. The language of claims 1 and 24 appear to define the claimed “gas storage and production system” as having both, (injecting gas and withdrawing gas), occur at the same time. Or, at least, having both wellbores filled with gas at the same time which is not presented within the instant specification. Here, again, claims 1 and 24 appear to present two statutory distinct inventions and, as such, it is unclear as to the metes and bounds of the language of claims 1-16 and 24-35.

As for Applicant’s arguments against the applied prior art, the recitation of “injecting gas” or “withdrawing gas” does not serve to establish a function of a component of the claimed “gas storage and production system”. Rather, the recitations of “injecting gas” or “withdrawing gas” merely present an intended use of the claimed “gas storage and production system”. As stated above the function of the wellbores would be to act as a conduit, (i.e., containment passage), during any process of injecting or withdrawing. Otherwise, the applied prior art does disclose the elements and features of the respectively rejected claims as has been set forth in the above rejections. A recitation of the intended use of the claimed invention must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. A recitation of intended use in a claim directed to a composition does not impose any limitations which differentiates the claimed composition from those which are known in the art. See *In re Pearson*, 494 F.2d 1399, 181 USPQ

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641 (CCPA 1974). Scott is capable of accepting gas through either of 11, (or lower portion thereof), and 11a while Pringle et al. is capable of accepting gas through either of 66 and 58. A recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed. See *Ex Parte Masham* 2 USPQ2d 1647. Similarly, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations of that claimed. See *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.



MICHAEL SAFAVI
PATENT EXAMINER
ART UNIT 3673

M. Safavi
August 5, 2003